REMARKS

A review of the claims indicates claims 1-13, 15 and 17-22 are in original form, and claims 14 and 16 are currently amended. In view of the following remarks, Applicant respectfully requests reconsideration of the rejected claims.

35 U.S.C. §102 Rejections

Applicant submits that the Office has failed to establish a *prima facie* case of anticipation and respectfully traverses the Office's rejections. However, before discussing the substance of the Office's rejections, a section entitled "The §102 Standard" is provided and will be used in addressing the Office's rejections. Following this section, a section entitled "The Hanagami Reference" is provided, which describes Hanagami's disclosure and teachings.

The §102 Standard

According to the MPEP §2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.

Anticipation is a legal term of art. The applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited

in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

The §102 rejection of claims 1-3 and 9-20 is believed to be in error. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

The applicant notes the requirements of MPEP §2131, which states "to anticipate a claim, the reference must teach every element of the claim." This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis

test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

The Hanagami Reference

The Hanagami reference discloses a video processing apparatus that prints a picture having an arbitrarily selected size without forging an original picture. That is, Hanagami discloses a way to print a photo of the selected size by using video data in such a way that interpolation-type processes are not required. Thus, the printed photo is more accurate, not resulting from data produced by "decimating processing" (e.g. interpolation). (See Hanagami, Abstract.)

In operation, Hanagami allows the user to select an arbitrary print size using a selecting means 51, and to adjust a picture frame accordingly (see FIG. 2). The selected picture size may be manually input by entering X- and Y-coordinate dimensions (col. 8, lines 30-35) or may be selected from among sizes associated with required passport photo dimensions of different countries (col. 8, lines 36-43).

It is a significant core aspect of Hanagami that a CPU 43 is configured to determine the number of pixels of a video data corresponding to the selected print size. Additionally, a memory controller 33 is configured to process the video data so that the number of pixels of video data output from a camera is in one-to-one correspondence with pixels of a

video data to be printed by the printer. (See the Abstract and other locations.)

Significantly, Hanagami has discovered how to control aspects of reading video data to result in the desired one-to-one correspondence. (See column 19, lines 36-49.) In large part, Hanagami controls the read sampling frequency (column 19, line 59 to column 20, line 34) in conjunction with aspects of the paper feed pitch (column 19, line 61) to correspond the video data to the print size.

Thus, having picked the size of the printed image (typically by entering the size directly or picking the required passport photo size of the appropriate country) the video data is processed by Hanagami's disclosure so that a one-to-one correspondence between pixels of a video data and the data sent to the printer. Accordingly, Hanagami avoids distortion of interpolation and similar processes wherein data may be "forged" (Hanagami's term) to fit the desired picture size. (See Hanagami, Abstract and other locations.)

It is instructive to note that the Applicant's claims recite "receiving an image" and "calculating a range of images sizes." In contrast, Hanagami starts by arbitrarily selecting the image size (Abstract, line 3), and then "controls the read sampling frequency" "in response to the print size selected" (column 20, lines 2-4) to get the "one-to-one" pixel "correspondence" (column 19, line 45). Thus, Hanagami *goes in reverse*—

starting with the image size, and then controlling sampling frequency to adjust data to correspond to that image size.

Traversal of the §102 Rejections

Claims 1-3 and 9-20 were rejected under §102 as being anticipated by U.S. Patent No. 6,687,020, hereinafter "Hanagami." In response, the Applicant respectfully traverses the rejection.

Claim 1 recites method for selecting a printed image size comprising steps of:

- receiving an image;
- **calculating a range of image sizes for printing said image based on a plurality of factors**; and
- **selecting at least one of said image sizes in said range** for printing said image.

Claim 18 is similar.

Hanagami allows the user to select a size of the image by direct means (e.g. entering the X and Y millimeters (col. 8, lines 31-35)) or indirectly (e.g. choosing a country, and automatically getting that country's passport photo size (col. 8, lines 37-43).

Having selected the image size, Hanagami applies a controller to the reader of the video source data to control the read sampling frequency and paper feed pitch to result in a one-to-one pixel correspondence (col. 19, linc 45 and also col. 20 lines 7, 20 and 34).

Thus, Hanagami does not *calculate* "a range of image sizes," and he does not do this "based on a plurality of factors." Rather than perform a calculation, Hanagami allows the user to select the desired image size (e.g. U.S. passport size). No calculation is performed.

Hanagami does not calculate a range of image sizes. In fact, Hanagami selects, rather than calculates, a *single* desire image size. E.g. the required size for a Japanese or American passport, or a driver's license. Having done so, Hanagami performs the core ideas of his disclosure, i.e. obtaining video data having a one-to-one relationship with the pixels of the selected image size.

Not only is the selection done without calculation, but it is done without calculation based on a plurality of factors. No factors for any calculation are enumerated in the recited passage in Hanagami. Accordingly, Hanagami does not disclose "calculating a range of image sizes for printing said image based on a plurality of factors."

The Patent Office suggests that Hanagami discloses the recited elements. The Applicant respectfully disagrees.

In fact, Hanagami discloses selecting the image size without calculation and without calculation based on a plurality of factors. Additionally, Hanagami discloses selection of a *single* image size, rather than *calculation of a range* of image sizes.

The Patent Office has pointed generally at column 6, line 27 to column 8, line 53 and column 19, line 59 to column 20, line 34, without showing a specific correlation between aspects of Hanagami's disclosure and the recited elements of the claims. If the Patent Office persists in this rejection, the Applicant respectfully

requests that the Patent Office disclose with more specificity the assumed similarities.

Therefore, Hanagami is deficient, and fails to disclose the elements recited by the Applicant's claims. Accordingly, the Applicant respectfully requests that the rejection of claims 1 and 18 be removed, and that these claims be allowed to issue.

Claim 2 recites the method of claim 1, further comprising:

- receiving a user-preferred image size;
- **determining whether said user-preferred image size is within said range.**

Claims 13 and 19 are similar.

Hanagami does not disclose a step wherein a determination is made if the user-preferred image size is within the range. This is because (1) Hanagami does not disclose calculating image sizes, or (2) a range of images sizes. Instead, Hanagami allows any arbitrarily-sized image to be selected (Abstract, line 2). Thus, no "determining" step is required. In Hanagami, the user simply selects the size of the image. Therefore, since any size of image may be selected (and the size entered in millimeters, for example, col. 8, lines 30-35) there is no need to determine if it is within a range.

The Patent Office suggests that Hanagami discloses in column 6, line 27 to column 8, line 53 and column 19, line 59 to column 20, line 34 the "receiving" and the "determining" steps. However, the Applicant respectfully disagrees.

The Hanagami reference discloses allowing the user to select an image of arbitrary size. Accordingly, Hanagami has no need of, and makes no disclosure of, determining if the selected image size is within a range.

Accordingly, the Applicant respectfully requests that the rejection of claims 2, 13 and 19 be removed, and that these claims be allowed to issue.

Claim 3 recites method of claim 2, wherein said step of selecting further comprises steps of:

- selecting said user-preferred image size for printing said image in response to said user-preferred image size being within said range; and
- selecting said at least one of said image sizes in said range for printing said image in response to said user-preferred image size falling outside of said range.

Claims 14 and 20 are similar.

Hanagami does not disclose a step of selecting an image size from a range, among other reasons, because Hanagami allows the selection of any arbitrarily sized image. Accordingly, Hanagami does not disclose the two alternatives recited by claim 3: wherein the image is within the range (paragraph 1 of claim 3) and is not within the range (paragraph 2 of claim 3).

The Patent Office suggests that Hanagami discloses in column 6, line 27 to column 8, line 53 and column 19, line 59 to column 20, line 34 the two alternatives presented in claim 3. The Applicant respectfully disagrees, and also respectfully requests that the Patent Office show the location of the two alternatives with more specificity.

Because the two alternatives of claim 3 do not appear to be disclosed by Hanagami, the Applicant respectfully requests that the rejection of claims 3, 14 and 20 be removed, and that these claims be allowed to issue.

Claim 9 recites method of claim 1, wherein:

- said plurality of factors includes one or more of resolution, aspect ratio, number of pixels per inch of a printed image, and image orientation.

Claim 15 is similar.

Hanagami does not disclose a step of "calculating a range of image sizes for printing said image based on a plurality of factors" enumerated in claim 1. Instead, Hanagami discloses a print size selecting means 51, which is key 6 (see the bottom of FIG. 6 and also column 8, lines 31-43). This allows the user to select an arbitrary image size (see Abstract, 3rd line and 2nd to bottom line). Thus, Hanagami does not disclose using the recited factors to calculate a range of image sizes.

The Patent Office suggests that Hanagami discloses in column 6, line 27 to column 8, line 53 and column 19, line 59 to column 20, line 34 the factors recited. The Applicant respectfully disagrees, and respectfully requests that the Patent Office show the location of the factors and their impact on the calculation of image sizes with more specificity. Again, the Hanagami image size is selected arbitrarily, by user input of the millimeters (column 8, lines 31-37) or from a list of country passport sizes (column 8, lines 38-43), and is not selected using the recited factors of claim 9. Hanagami discloses no calculation, and therefore no factors by which the calculation is made.

Because the factors of claim 9 are not disclosed by Hanagami, the Applicant respectfully requests that the rejection of claims 9 and 15 be removed, and that these claims be allowed to issue.

Claims 10, 11 and 16 depend from Claim 1 and are allowable due to their dependence from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in Claim 1, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Claim 12 recites a method for printing an image comprising:

- receiving an image;
- calculating a range of image sizes for printing said image based on a plurality of factors; and
- printing said image in a size in said range.

Claims 17 is similar. Both claims are allowable for most of the same reasons as claim 1, and the arguments set forth in that section are incorporated herein by reference. Accordingly, the Hanagami reference is deficient, and the Applicant respectfully requests that the rejection of claims 12 and 17 be removed.

The §103 Rejections

Claims 4-8 and 21-22 were rejected as being unpatentable over Hanagami in view of U.S. Pat. No. 6,587,221, hereinafter "Young."

The Applicant submits that the Office has failed to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office's rejections. However, before discussing the substance of the Office's

rejections, a section entitled "The §103 Standard" is provided and will be used in addressing the Office's rejections.

The §103 Standard

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine or modify the references relied on as evidence of obviousness. The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

Claim 4 recites method of claim 1, wherein said step of calculating further comprises:

- determining an aspect ratio of said image; and
- calculating said range, whereby an image printed in each of said sizes in said range has an aspect ratio approximately equal to an aspect ratio of said received image.

Claims 4 depends from Claim 1 and is allowable due to it dependence from an allowable base claim. Moreover, nothing in the Young reference remedies the deficiencies in the Hanagami reference with respect to the rejection of claim 1. Accordingly, the rejection of claim 1 is still deficient, and claim 4 is allowable as depending from an allowable claim.

Additionally, Young does not address, in the cited passage, the recited elements of claim 4. For example, calculating the range, and other aspects of claim 4, do not appear in Young. If the Patent Office persists in this rejection, the Applicant respectfully requests that the basis of the rejection be more specifically pointed out.

Claim 5 recites method of claim 4, wherein said step of calculating further comprises steps of:

- determining a resolution of said received image;
- determining a resolution of a printer printing said image;
- correlating said resolution of said received image and said printer; and
- **calculating said sizes in said range,** whereby an image printed in each of said sizes in said range has a resolution associated with said correlated resolution.

Claim 5 depends from Claim 1 and is allowable due to its dependence from an allowable base claim. Additionally, claim 5 recites detail of the calculation of the sizes of the range. As seen above, Hanagami does not disclose calculation of an image. Instead, Hanagami discloses that the image size may be selected to be any arbitrary size.

Additionally, Hanagami fails to disclose a plurality of image sizes (the range). More particularly, Hanagami fails to disclose a plurality of image sizes wherein each size has a resolution associated with said correlated resolution. In contrast, Hanagami discloses a single image size.

Because the elements of claim 5 are not disclosed by Hanagami, the Applicant respectfully requests that the rejection of claim 5 be removed, and that this claim be allowed to issue.

Claims 6, 7 and 8 depend from Claim 1 and are allowable due to their dependence from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in Claim 1, are neither disclosed nor suggested in references of record, either singly or in combination with one another. Generally, Hanagami fails to disclose the step of calculating a range of image sizes. More particularly, Hanagami fails to disclose calculating a range of image sizes according to the detail recited in claims 6 and 7. Instead, Hanagami discloses selection of any arbitrary size for the image, without calculation. Moreover, Hanagami discloses selection of a single image size, and not a range.

The Patent Office suggests that the elements of claims 6, 7 and 8 are shown in column 6, line 27 to column 8, line 53 and column 19, line 59 to column 20,

line 34. However, the Applicant fails to see the recited elements disclosed, and respectfully asks the Patent Office to more particularly point them out if the rejection is maintained.

Claims 21 and 22 depend indirectly from Claim 17 and are allowable due to their dependence from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in the claims from which they depend, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Conclusion

The Applicant submits that all of the claims are in condition for allowance and respectfully requests that a Notice of Allowability be issued. If the Office's next anticipated action is not the issuance of a Notice of Allowability, the Applicant respectfully requests that the undersigned attorney be contacted for the purpose of scheduling an interview.

Respectfully Submitted,

Dated: 4-8-05 By: David S. Thompson

David S. Thompson
Reg. No. 37,954
Attorney for Applicant

LEE & HAYES PLLC
Suite 500
421 W. Riverside Avenue
Spokane, Washington 99201
Telephone: 509-324-9256 x235
Facsimile: (509) 323-8979